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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/924,056	08/08/2001	Shell S. Simpson	10015147-1	1473

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HEWLETT-PACKARD COMPANY  
Intellectual Property Administration  
P.O. Box 272400  
Fort Collins, CO 80527-2400

EXAMINER
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ANYA, CHARLES E

ART UNIT	PAPER NUMBER
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2126

DATE MAILED: 05/03/2004

2

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/924,056

Applicant(s)

SIMPSON ET AL.

Examiner

Charles E Anya

Art Unit

2126

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 August 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

1. Claims 1-15 are pending in this applications.

***Specification***

2. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed. The current title is imprecise.

Please amend the title to reflect as follows:

"Web imaging system for creating and providing an opaque reference to a web browser, without supplying a reference to the resource or the imaging client specific command to the web browser".

3. Applicant's specification [p. 38 – p.43 paragraph 0124] filed on 8/8/01 is objected because it includes "computer program listing" having over 300 lines.

If the citing of the "computer program listing" necessary to make the invention work, applicant is required to incorporate the content of the "computer program listing" as an appendix and submit it in a compact disk form.

Any "computer program listing appendix" having over 300 lines must be submitted on a compact disc in compliance with § 1.52(e). A compact disc containing such a computer program listing is to be "referred to" as a "computer program listing appendix filed in compact disk form at the beginning paragraph of the specification." The computer program listing appendix will not be part of the printed patent. See MPEP 608.05.

In addition, any reference to the "computer program listing" in the specification should be amended to incorporate these changes.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 6 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

6. Claims 5 and 6 recite the limitation "the external web content" and "the external" in lines 22 and 25 respectively. There is insufficient antecedent basis for this limitation in the claim.

For the purpose of this office action the examiner would change the phrases "the external web content" and "the external" to "the web content".

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

Art Unit: 2126

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**8. Claims 1-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Pat. No. 6,317,777 B1 to Skarbo et al. in view of U.S. Pat. No. u.S. Pat. No. 6,691,153 B1 to Hanson et al.**

9. As to claim 1, Skarbo teaches a computer implemented method for operating a web imaging system for use with a browser on an imaging client, comprising the steps of: receiving a request from external web content for a reference to a resource (figurer 6 Col. 10 Ln. 26 – 35), creating an opaque reference that is mapped to the imaging client specific command and providing this opaque reference to the web content, without supplying a reference to the resource or the imaging client specific command to the web content (Col. 9 Ln. 16 – 67, Col. 10 Ln. 1 – 25).

10. Skarbo is silent with reference to translating the request to an imaging client specific command.

11. Hanson teaches translating the request to an imaging client specific command (figure 7 Col. 12 Ln. 25 – 46).

12. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Hanson and Skarbo because the teaching of Hanson would improve the system of Skarbo by providing a means for rendering dynamic content (Col. 12 Ln. 25 – 46).

13. As to claim 2, Skarbo teaches the method as defined in claim 1, wherein an imaging extension performs the receiving, translating and mapping steps, and wherein the imaging extension does not accept a reference from the web content (Col. 9 Ln. 16 – 67, Col. 10 Ln. 1 – 25).

14. As to claim 3, Skarbo teaches the method as defined in claim 1, wherein the resource is associated with the personal imaging repository of a user (Col. 3 Ln. 56 – 67).

15. As to claim 4, Skarbo teaches the method as defined in claim 1, wherein a reference from the web content will be accepted if the reference or the web content meets a criteria (figure 5 Col. 8 Ln. 11 – 39).

16. As to claim 5, Skarbo teaches the method as defined in claim 4, wherein the criteria is that the reference is from the same source as the external web content (figure 5 Col. 8 Ln. 11 – 39).

17. As to claim 6, Skarbo teaches the method as defined in claim 4, wherein the criteria is that the external web content includes predetermined credentials (figure 5 Col. 8 Ln. 11 – 39).

18. As to claim 7, Skarbo teaches the method as defined in claim 1, further comprising the steps of calling an imaging extension API that interacts with the personal imaging repository resources and wherein the mapping step comprises mapping to a resource from the user's personal imaging repository (Col. 3 Lon. 56 – 67).

19. As to claim 8, Skarbo teaches the method as defined in claim 7, wherein the API creates a session with a session id that is used to facilitate obtaining the opaque reference (Col. 8 Lon. 1 – 10).

20. As to claim 9, Skarbo teaches the method as defined in claim 8, wherein the opaque reference is mapped in the mapping step to a reference for a personal imaging repository resource, but this mapping is deleted when the session ends (Col. 8 Lon. 1 – 10).

21. As to claim 10, Skarbo teaches the method as defined in claim 8, wherein the imaging extension API calls at least one API for one of the personal imaging repository resources (Col. 8 Lon. 1 – 10).

22. As to claim 11, Skarbo teaches the method as defined in claim 1, wherein the opaque reference is originated by the imaging extension and is only recognized by the imaging extension (Col. 9 Lon. 66 – 67, Col. 10 Lon. 1 – 15).

23. As to claim 12, Skarbo teaches the method as defined in claim 7, further comprising the step of receiving at the imaging extension a reference from the web content; accessing an imaging extension API to map the reference received from the web content to an opaque reference and creating a mapping relationship in the imaging extension between the received reference and the opaque reference and adding the opaque reference to a graphic (Col. 9 Lon. 66 – 67, Col. 10 Lon. 1 – 15).

24. As to claim 13, Skarbo teaches the method as defined in claim 12, wherein the imaging extension API is only accessed if credentials of the web content are accepted by the imaging extension (Col. 8 Lon. 11 – 32).

25. As to claims 14 and 15, see the rejection of claim 1.

### ***Conclusion***

26. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Pat. 6,393,468 B1 to McGee.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles E Anya whose telephone number is (703) 305-3411. The examiner can normally be reached on M-F (8:30-6:00) First Friday off.



Art Unit: 2126

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, An Meng-Ai can be reached on (703) 305-9678. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Charles E Anya  
Examiner  
Art Unit 2126

cea.



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